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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,419	10/27/2000	Gabriel Vogeli	28341/6276NCP	5650

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EXAMINER

ULM, JOHN D

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 01/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/698,419

Applicant(s)

Vogell et al.

Examiner

John Ulm

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Oct 27, 2000
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 8, 12-48, and 52-77 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 8, 12-48, and 52-77 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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1) Claims 8, 12 to 48 and 52 to 77 are pending in the instant application. Claims 8, 12 to 16, 18, 19, 22, 24, 26 to 28, 31, 35, 39, 41 to 47 and 75 have been amended and claims 1 to 7, 9 to 11 and 49 to 51 have been canceled as requested by Applicant in Paper Number 5, filed 27 October of 2000.

2) Claims 54 and 65 are objected to as reciting an improper Markush Group.

M.P.E.P. 803.02 states that:

“Since the decisions in *In re Weber* \*\*, 198 USPQ 328 (CCPA 1978); and *In re Haas*, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); *Ex Parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility and (2) share a substantial structural feature disclosed as being essential to that utility.”

The plurality of sequences recited in these claims do not appear to share a common utility which is based upon a common structural feature lacking from the prior art.

3) Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 8, 12 to 16 and 41, drawn to an isolated polypeptide comprising SEQ ID NO:14, classified in class 530, subclass 350.

II. Claims 17 to 30 and 67 to 72, drawn to an isolated polynucleotide encoding SEQ ID NO:14 and a method of use, classified in class 435, subclass 69.1.

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- III. Claims 31 to 37, 39, 40 and 42, drawn to an antibody which binds to a polypeptide having the amino acid sequence of SEQ ID NO:14, classified in class 530, subclass 388.22.
- IV. Claim 38, drawn to an anti-idiotypic antibody, classified in class 530, subclass 387.2.
- V. Claims 43 and 44, drawn to a method of treatment by administering an antibody, classified in class 424, subclass 130.1.
- VI. Claims 45 to 48 and 73, drawn to a binding assay employing a transfected cell, classified in class 435, subclass 7.1.
- VII. Claim 52, drawn to a method of treatment by administering a compound of unspecified constitution, classification undeterminable.
- VIII. Claim 53, drawn to a diagnostic method involving the detection of a protein, classified in class 436, subclass 63.
- IX. Claims 56 to 63, 65 and 66, drawn to a method of genetic analysis, classified in class 435, subclass 6.
- X. Claim 64, drawn to kit comprising nucleic acid primers, classified in class 536, subclass 24.31.
- XI. Claims 74 to 77, drawn to a binding assay employing an isolated protein, classified in class 436, subclass 501.

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The inventions are distinct, each from the other because:

The polypeptide that is invention I, the nucleic acid that is invention II, the antibody that is invention III, the anti-idiotypic antibody that is invention IV, the compound of unspecified constitution that is employed in the process of invention VII and the nucleic acid primers that are contained in the kit that is invention X are six structurally and functionally different chemical compounds, as shown by their different classification, each of which can be made and used without any one or more of the other compounds.<sup>1</sup> Lack of unity is shown because these six compounds lack a common utility which is based upon a common structural feature lacking from the prior art.

Invention I is related to each of inventions VI and X as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polynucleotide of invention I can be employed as a probe to detect complementary nucleic acids in a sample, which is materially different from the binding assay that is invention VI.

Inventions II and XI are related as product and process of use. They are distinct because the protein of invention II can be employed as an immunogen, which is materially different from the binding assay that is invention XI

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Invention III is related to each of inventions V and VIII as product and process of use. Because the method of treatment that is invention V and assay of invention VIII are materially different because they have different objectives which are achieved by different means, invention III is distinct therefrom.

Invention X is related to invention IX as product and process of use. These inventions are distinct because the method of invention IX can be practiced with the nucleic acid of invention I, which is materially different from the primers of invention X.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Ulm whose telephone number is (703) 308-4008. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached at (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242 or (703) 872-9306.  
Official responses under 37 C.F.R. § 1.116 should be directed to (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



JOHN ULM  
PRIMARY EXAMINER  
GROUP 1800